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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/506,779 02/18/00 CURRAN

D 99-038

EXAMINER

HM22/0920

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Suite 1801 Law & Finacne Building  
429 Fourth Avenue  
Pittsburgh PA 15219

GARCIA, M

ART UNIT

PAPER NUMBER

1627

DATE MAILED:

09/20/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/506,779

Applicant(s)  
Curran et al

Examiner  
Maurie E. Garcia, Ph. D.

Art Unit  
1627



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ONE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-45 are subject to restriction and/or election requirements.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

**Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1627 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Jyothsna Venkat, Supervisory Patent Examiner, at (703) 308-2439. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

#### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1 (in part), 2, 3, 10, 11-16 and 45, drawn to a method of separating compounds based upon difference in fluorous nature, classified in various classes/subclasses, for example, class 210, subclasses 656 or 690.
  - II. Claims 1 (in part), 4, 5, 10 and 45, drawn to a method of separating compounds based upon differences in total charge, classified in various classes/subclasses, for example, class 204, subclasses 450-455 or class 210, subclass 656.
  - III. Claims 1 (in part), 6, 7, 10 and 45, drawn to a method of separating compounds based upon differences in size, classified in various classes/subclasses, for example, class 210, subclasses 635, 649 or 654.
  - IV. Claims 1 (in part), 8-10 and 45, drawn to a method of separating compounds based upon differences in polarity, classified in various classes/subclasses, for example, class 210, subclasses 638, 656 or 660.
  - V. Claims 17-21 and 28-44, drawn to a method for carrying out a chemical reaction using fluorous tagging moieties, classified in various classes/subclasses depending on the compounds and tags, for example, class 570, subclasses 127-136.

- VI. Claims 17, 18, 22, 23 and 28-32, drawn to a method for carrying out a chemical reaction using tagging moieties differing in total charge, classified in various classes/subclasses depending on the compounds and tags, for example, class 564, subclasses 281-290.
- VII. Claims 17, 18, 24, 25 and 28-32, drawn to a method for carrying out a chemical reaction using oligomer, polymer or dendrimer tagging moieties, classified in various classes/subclasses depending on the compounds and tags, for example, class 528, subclasses 491-498.
- VIII. Claims 17, 18, 26, 27 and 28-32, drawn to a method for carrying out a chemical reaction using tagging moieties differing in polarity, classified in various classes/subclasses depending on the compounds and tags, for example, class 585, subclasses 16-27.

- 2. The inventions are distinct, each from the other because of the following reasons:
- 3. Groups I – VIII are different methods. The methods are different because they use different steps, require different reagents and will produce different products and/or results. They therefore have different issues regarding patentability and enablement and represent patentably distinct subject matter. This is elaborated upon below.
- 4. In the instant case, the methods of Groups I-IV and V-VIII are different from each other because they have completely different steps and end results. The methods of Groups V-VIII require that “at least one chemical reaction” is performed; this is not required for Groups I-IV. Furthermore, the methods of Groups I-IV are methods “of separating compounds”, while the methods of Groups V-VIII are methods “for carrying out a chemical reaction”. These are clearly different end results.

5. The methods of Groups I & V; II & VI; III & VII and IV & VIII are different because each of these methods relies on a different chemical/physical mechanism for separation. That is, Groups I & V rely on difference in fluororous nature/fluororous tags; Groups II & VI rely on differences in total charge; Groups III & VII rely on differences in size/oligomer, polymer or dendrimer tags; and Groups IV & VIII rely on differences in polarity. Each of these are distinct, each from the other, because the structures of the tags involved and the modes of action (for separation) are different. The starting materials from which each of the tags are made is also different. They would also differ in their reactivity (for Groups V-VIII). Therefore, for these reasons, these groups are deemed to have different issues regarding patentability and enablement and to represent patentably distinct subject matter.

6. These inventions have acquired a separate status in the art as shown by their different classification and divergent subject matter. Each of the different methods would require completely different searches in the patent and non-patent databases, and there is no expectation that the searches would be coextensive. Therefore, this does create an undue search burden, and restriction for examination purposes as indicated is proper.

7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). Because the above restriction/election requirement is

complex, a telephone call to applicants to request an oral election was not made. See MPEP § 812.01.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

9. Applicant is also reminded that a 1 - month (not less than 30 days) shortened statutory period will be set for response when a written requirement is made without an action on the merits. This period may be extended under the provisions of 37 CFR 1.136(a). Such action will not be an "action on the merits" for purposes of the second action final program, see MPEP 809.02(a).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie E. Garcia, Ph.D. whose telephone number is (703) 308-0065. The examiner can normally be reached on Monday-Thursday from 9:00 to 6:30 and on alternate Fridays.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat, can be reached on (703) 308-2439. The fax phone number

for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Maurie E. Garcia, Ph.D.  
September 6, 2001

A handwritten signature in black ink, appearing to read 'Maurie E. Garcia', with a long horizontal flourish extending to the right.

**MAURIE E. GARCIA, Ph.D.  
PATENT EXAMINER**



# RESTRICTION ELECTION FACSIMILE TRANSMISSION

DATE:

FROM/ATTORNEY:

FIRM:

PAGES, INCLUDING COVERSHEET:

PHONE NUMBER:

TO EXAMINER: Maurie E. Garcia, Ph.D.

ART UNIT: 1627

SERIAL NUMBER:

FAX/TELECOPIER NUMBER: (703) 305-3704

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